

REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims comply with 35 U.S.C. § 112, are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. **If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before issuing any further actions on the merits.**

The applicants will now address each of the issues raised in the outstanding Office Action. Before doing so, however, the undersigned likes to thank Examiner Lastra for courtesies extended during a telephone interview on March 30, 2009 (referred to as "the telephone interview"). The telephone interview is summarized here.

Telephone Interview Summary

This statement of the substance of the Interview summarizes the issues discussed during the March 30, 2009 telephone interview. This Interview Summary is presented in the format suggested in MPEP § 713.04 by the Patent Office.

Date of Interview: March 30, 2009

Type of Interview: Telephone

Name of Participants:

- Examiner: Daniel Lastra
- For Applicants: John C. Pokotylo
Darren Kang

A. Exhibit(s) Shown:

- None

B. Claims discussed:

- Claims 1, 19, 34, 40, 43, 45, 47, 65, 80, 86, 89 and 91

C. References Discussed:

- U.S. Patent Application Publication No. 2003/0191689 ("the Bosarge publication")

D. Proposed Amendments discussed:

- None

E. Discussion of General Thrust of the Principal Arguments

- The applicants' representatives described the claimed invention, their understanding of the teachings of the Bosarge publication, and the main differences between the claimed invention and the teachings of the cited reference. In particular, the applicants' representatives discussed the serving/rendering of the requested document with respect to a client device in an exemplary method consistent with the invention (in relation to

requesting at least one ad or an additional content item). The applicants' representatives also noted that in the exemplary method, the client device user benefits by not waiting for the ad to be rendered. The applicants' representatives directed the Examiner to the "fingerprint" feature in FIGS. 2 and 5 used to match retrieved ads with an ad request sourced from a client device in order to help the Examiner to better understand how embodiments consistent with the claimed invention might operate.

- The Examiner, noted that he focused on the content relevant ad feature, and agreed that the Bosarge publication does not disclose the discussed features of the invention.

F. Other Pertinent Matters Discussed:

- None

G. General Results/Outcome of Interview

- The Examiner suggested responding to the currently outstanding final Office Action. Once he receives the reply, he will determine whether to reopen the prosecution by issuing a non-final Office Action.

Objections

Claim 39 is objected to because it repeats the same limitations as claim 36. The applicants respectfully request that the Examiner withdraw this ground of objection.

Claim 39 has been canceled, rendering this ground of rejection moot.

Rejections under 35 U.S.C. § 102

Claims 1-23, 25-69 and 71-92 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the Bosarge publication. The applicants respectfully request that the Examiner withdraw this ground of rejection in view of the following three reasons.

I. The Bosarge Publication Does Not Teach Accepting, an Ad Request from the Client Device to Which the Requested Document Has Been Served

First, independent claim 1 is not anticipated by the Bosarge publication because the Bosarge publication does not teach (1) ***serving to a client device, with the web-based e-mail serving system, the requested document*** in association with the request identifier, (2) obtaining, with the web-based e-mail serving system, at least one ad relevant to the e-mail content, (3) ***storing, with the web-based e-mail serving system, the obtained at least one ad***, (4) accepting, with the web-based e-mail serving system, an ***ad request from the client device***, (5) ***reading***, with the web-based e-mail serving system, the stored at least one ad using information from the ad request, and (6) ***serving to the client device, with the web-based e-mail serving system, the at least one ad read***.

In the previous Remarks/Arguments section of the Amendment dated December 23, 2008, the applicants argued (1) that exemplary methods consistent with the claimed

invention accept an ad request from the client device different from the "electronic messages" which are [already] enhanced with ads and transmitted "to a receiver" (Abstract of the Bosarge publication); (2) that the directional flow of FIG. 2 supports the interpretation that "ads are pulled and appended ... and transmit[ted] to the recipient [in] an enhanced email." (Paragraph [0057] of the Bosarge publication); (3) that "since the ads are **already appended** to the electronic message, there is no need for the receiving device to request the ads" in the Bosarge publication; and (4) that "the 'hyper linked word' disclosed in paragraph [0054] of the Bosarge publication would request ads after the enhanced message (along with the appended ads) has been rendered to the receiver." [Emphasis added.] (The hyper linked word's landing page is not stored for reading and serving by a web-based e-mail serving system) (Page 30 of the Amendment dated December 23, 2008)

In the Response to Arguments section of the current Office Action (dated February 7, 2009), the Examiner replies:

Bosarge teaches that the email client is configured so that all outgoing SMTP email is sent directly to a[n] OpenMX Mail server where an intelligent ad request is made to the advertisement service provider web server in order to attach an advertisement to the email (see paragraph 56).

(Paper No. 20090207, page 15) The applicants respectfully disagree.

The "OpenMX Mail Server" is not mentioned anywhere in paragraph [0056] of the Bosarge publication.

Paragraph [0057], which mentions the "OpenMX Server", states a "direct MX lookup is then performed ... to provide and transmit to the recipient an enhanced email." (Paragraph [0056] of the Bosarge publication) An enhanced email already including an ad negates the need for the client device to request an ad. By contrast, in exemplary methods consistent with the claimed invention, the web-based e-mail serving system distinctively accepts an ad request from the client device. Thus, the client device can render the received document content regardless of whether the ad has been received. The client device requests an ad from the web-based e-mail serving system (clearly illustrated by elements 150 a, b and c in FIG. 5). The disclosure of the present application explicitly describes this advantageous embodiment of the claimed invention as:

an **asynchronous** and opportunistically available solution that allows the user's e-mail to be rendered immediately, and **then** updated with appropriate advertisements if and when they became available. [Emphasis added.]

(See paragraph [0079] of the present application.) The disclosure of the Bosarge publication fails to disclose such inventive features.

Thus, independent claim 1 is not anticipated by the Bosarge publication for at least the foregoing reasons. Since claims 2-18 directly or indirectly depend from claim 1, these claims are similarly not anticipated by the Bosarge publication. Independent claims 34, 40, 45, 47, 80, 86 and 91, as amended, are similarly not anticipated by the Bosarge publication. Since claims

35-39 directly or indirectly depend from claim 34, since claims 41 and 42 directly or indirectly depend from claim 40, since claim 46 depends from claim 45, since claims 48-64 directly or indirectly depend from claim 47, since claims 81-85 directly or indirectly depend from claim 80, since claims 87 and 88 depend from claim 86 and since claim 92 depends from claim 91, these claims are similarly not anticipated by the Bosarge publication.

II. The Bosarge publication Does Not Teach Rendering the Ad After the E-mail Content of the Document Has Been Rendered

In the Remarks/Arguments section of the previously presented Amendment (dated December 23, 2008), the applicants noted that rendering, with a client device, the at least one ad in association with the rendered document, wherein **the at least one ad is rendered after the e-mail content of the document has already been rendered** as recited in independent claims 19 and 65 (Page 31 of the Amendment dated December 23, 2008) is different from the process discussed in "Paragraph [0018] of the Bosarge publication, cited by the Examiner.

In the Response to Arguments section of the current Office Action (dated February 7, 2009), the Examiner replies:

Bosarge teaches transmitting the email content to a recipient (i.e. rendering) and **after** said transmitting attaching an ad to said email content (see figure 2).
[Emphasis added.]

(Paper No. 20090207, page 15) The applicants respectfully disagree.

As agreed by the participants during the interview of March 30, 2009, FIG. 2 and the disclosure of the Bosarge publication do not disclose **rendering** the ad **after** the e-mail content of the document has already been **rendered**.

Thus, independent claims 19 and 65, as amended, are not anticipated by the Bosarge publication for at least the foregoing reasons. Since claims 20-29 directly or indirectly depend from claim 19, and since claims 66-79 directly or indirectly depend from claim 65, these claims are similarly not anticipated by the Bosarge publication. Independent claims 43 and 89, as amended, are similarly not anticipated by the Bosarge publication. Since claim 44 depends from claim 43, and since claim 90 depends from claim 89, these claims are similarly not anticipated by the Bosarge publication.

III. The Bosarge publication Does Not Teach Requesting at least One Ad Relevant to the E-mail Content of the Document After the Act of Rendering the E-mail Content of the Document Occurs

In the Remarks/Arguments section of the previously presented Amendment (dated December 23, 2008), the applicants noted that dependent claims 21 and 67 are not anticipated by the Bosarge publication because the Bosarge publication does not teach **requesting** at least one ad relevant to the e-mail content of the document **after** the act of rendering the e-mail content of the document occurs.

In the Response to Arguments section of the current Office Action (dated February 7, 2009), the Examiner replies:

Bosarge teaches parsing the email content for keywords in order to target and render ads related to the content of said email content (see paragraph 55).

(Paper No. 20090207, page 16) The applicants respectfully disagree.

Similar to the above argument, the feature of requesting at least one ad relevant to the e-mail content of the document **after** the act of rendering the e-mail content of the document occurs is not shown in paragraph [0055] or elsewhere in the Bosarge publication.

Thus, dependent claims 21 and 67 are not anticipated by the Bosarge publication for at least this additional reason.

Rejections under 35 U.S.C. § 103

Claims 24 and 70 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Bosarge publication. The applicants respectfully request that the Examiner withdraw this ground of rejection in view of the following.

Claims 24 and 70 indirectly depend from claims 19 and 65, respectively. The purported allegation that instantiating an ActiveX object in order to pull an ad is old and well known art would not compensate for the deficiencies of the Bosarge publication with respect to claims 19 and 65 (discussed above), regardless of whether

the instantiating is old and well known art, and regardless of the absence or presence of an obvious reason for a person of ordinary skill in the art "to know that Bosarge would instantiate ActiveX to obtain ads." (Paper No. 20090207, page 13) Consequently, claims 24 and 70 are not rendered obvious by the cited reference and the Official Notice for at least this reason

Claim amendments

Claims 39 has been canceled to overcome the claim objection mentioned above. Since 37 C.F.R. § 1.116(b)(1) states that "[a]n amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action", this cancellation of claim 39 should be entered.

Conclusion

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

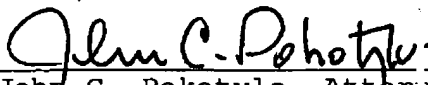
Any arguments made in this amendment pertain **only** to the specific aspects of the invention **claimed**. Any claim amendments or cancellations, and any arguments, are made **without prejudice to, or disclaimer of**, the applicants' right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

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Since the applicants' remarks, amendments, and/or filings with respect to the Examiner's objections and/or rejections are sufficient to overcome these objections and/or rejections, the applicants' silence as to assertions by the Examiner in the Office Action and/or to certain facts or conclusions that may be implied by objections and/or rejections in the Office Action (such as, for example, whether a reference constitutes prior art, whether references have been properly combined or modified, whether dependent claims are separately patentable, etc.) is not a concession by the applicants that such assertions and/or implications are accurate, and that all requirements for an objection and/or a rejection have been met. Thus, the applicants reserve the right to analyze and dispute any such assertions and implications in the future.

Respectfully submitted,

July 18, 2009

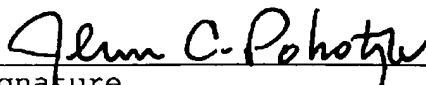

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July 18, 2009
Date